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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 10/010,242 | 12/06/2001 | Paul Douglas Becherer | 8202 | 5768 |
| 1688 | 7590 | 05/06/2004 | EXAMINER | |
| POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615 | | | SUGARMAN, SCOTT J | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 2873 |

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------|-----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/010,242 | BECHERER ET AL. | |
| Period for Reply | Examiner | Art Unit | |
| | Scott J. Sugarman | 2873 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 February 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-4,6,7,10-14,16,17 and 20-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 1-4,6,7 and 10-14 is/are allowed.

6) Claim(s) 16,17 and 20-32 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 06 December 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

Claims 1-4, 6, 7 and 10-14 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the independent claims, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented, for example, in independent claim 1, which include a generally circular lens body having an anterior surface and a posterior surface for engaging the subject's eye, the lens having a substantially clear, annular center area greater than approximately 4 mm in diameter for positioning over a pupil of the eye and an adjacent light restricting area surrounding the substantially clear center area, the light restricting area having an annular inner margin and an annular outer margin and uniform opacity across the expanse between the recited margins and disposed to impinge upon and restrict the light that enters a dilated pupil of the eye through the substantially clear center area.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16, 17, 20-30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoyan (US 5,191,365). Stoyan teaches a lens having a substantially circular lens body, a posterior surface having a configuration to accommodate a flattened corneal surface including a relatively flat center area, having a generally uniform radius of curvature of between 9.2 to 10.5 mm, a second area adjacent the relatively flat center area, the second area has a smaller radius of curvature between 11-14 mm, and a third peripheral area that is flatter than the second area (col. 2, line 47-col. 3, line 45; col. 3, line 60-col. 4, line 11). Note, that once the lens changes the shape of the cornea, it automatically meets the limitation of the claims as fitting exactly as claimed (no changes will occur until another lens in the series is placed on the eye).

Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Borowsky. Borowsky teaches a lens (11) having a means (15 minus 13) for positioning over the pupil of the eye to allow the passage of light into the pupil of the eye and means for restricting (13) the light passing through the first recited means and into the dilated pupil.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16 (dependent claims 17, 20-21), 29 (dependent claim 30) and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe correcting vision without physically changing the shape of the underlying cornea.

Response to Arguments

Applicant's arguments with respect to claims 1-4, 6, 7, 10-14, 16, 17 and 20-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott J. Sugarman whose telephone number is (571)272-2340.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott J. Sugarman
Primary Examiner
Art Unit 2873

sjs
April 30, 2004